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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,424	05/09/2001	Yuji Tsukamoto	040447-0233	2129

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EXAMINER	
BACKER, FIRMIN	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/851,424	TSUKAMOTO ET AL	
	Examiner	Art Unit	
	FIRMN BACKER	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Allen (U.S. Patent No. 5,909,638) in view of Phillipo et al (U.S. PG Pub No. 20050246284 A1)

4. As per claim 1, Allen teaches a contents rental system (*video kiosk, 123a-n)* comprising a content producer (*archive data, 1805)* for producing a content, a rental business server (*point of sale or rental retail transaction engine, 121)*, disposed in a store (*retail outlet, fig 17-20)* managed by a rental business operator, for recording the content produced by the content producer and downloading the contents to a record medium (*vhs)* corresponding to a command issued by a customer, and a reproducing device, disposed in a house of the customer, for reproducing the contents from the record medium (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28,*

7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43), wherein the content storing portion interfaces with the rental business server or the reproducing device through a first data interface, and the controlling portion interfaces with the rental business server or the reproducing device through a second data interface different from the first data interface (*see column 7 line 53 to col. 8 line 14)* . Allen fail to teach a system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed. However, Phillipo et al teach a system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed (*see paragraphs 0015, 002, claims 19-21).* Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Allen's rental system to include Phillipo et al's system wherein the record medium comprises a controlling portion controlling at least one of the recording or the reproducing of the content through at least one of the methods of confirming an encryption code or checking whether a predetermined time has elapsed because this would have discourage illicit copying from a digital record carrier to a computer-readable data storage device.

5. As per claim 2, Allen teaches a contents rental system wherein the rental business operator records an advertisement picture to the record medium along with the content such

advertisement picture is reproduced by the reproducing device dispose on the premise of the customer (*see fig 1, col. 21 lines 10-25).*

6. As per claim 3, Allen teaches a contents rental system wherein when an icon contained in the advertisement picture is clicked when the advertisement picture is reproduced by the reproducing device dispose on the premise of the customer, the reproducing device is connected to an advertisement server through the Internet (*see fig 1, col. 21 lines 10-25).*

7. As per claim 4, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content encrypted, a memory for storing a decryption key for decrypting the content encrypted; and a capacitor for backing up the memory, wherein the capacitor is charged by the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43).*

8. As per claim 5, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content; a memory for storing a control algorithm for reading the content; and a capacitor for backing up the memory, wherein the capacitor is charged by the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43).*

9. As per claim 6, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content encrypted; a memory for storing a decryption key for decrypting the content; and a timer for causing the decryption key stored in the memory to be erased when a predetermined time period elapses after the record medium is connected to the rental business server (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43).*

10. As per claim 7, Allen teaches a contents rental system wherein the record medium comprises: a content storing portion for storing the content; a memory for storing a control algorithm for reading the content; and a timer for causing the control algorithm stored in the memory to be erased when a predetermined time period elapses after the record medium is connected to the rental business (*see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43).*

11. As per claim 8, Allen teaches a contents rental system comprising: a capacitor, charged by the rental business server, for supplying a power to the timer *(see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43).*

12. Claims 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent No. 5,909,638) in view of Kambayashi et al (U.S. PG Pub No. 20020002466).

13. As per claim 9, Allen teaches a contents rental system for downloading a content to a record medium of a customer comprising: a content producer for producing the content; a management center for delivering the content produced by the content producer to a plurality of rental business operators; a rental business server, disposed in a store managed by each of the rental business operators, for recording the content delivered from the management center, downloading the recorded content to the record medium corresponding to a command issued by the customer and a reproducing device, disposed in a house of the customer for restoring the content from the record medium *(see fig 17-20, col. 5 lines 34-62, 6 lines 3-28, 7 lines 45-col. 8 line 34, 9 line 5-10 line 30, 11 lines 15-12 line 37, 21 lines 10-42, 23 line 34-24 line 43)*. Allen fails to teach or suggest a system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device. However, Kambayashi et al teach and suggest a system wherein the content on the record medium device is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on the same IC card electrically connected to the reproducing device with the IC card in store (*see fig 76, paragraphs 0004, 0014-0016, 00373, 00443).* Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to modify Allen's system to include Kambayashi et al's system wherein the content on the record medium is encrypted based on data stored on the IC card electrically connected to the rental business server and wherein the reproducing device decrypts the content using the data on

the same IC card electrically connected to the reproducing device because this would have enhance the security of the system.

14. As per claim 10, Kambayashi et al teach a contents rental system wherein when the IC card is set to the reproducing device, the reproducing device authenticates the IC card and the IC card authenticates the reproducing device (*see pp 0725-0728)*.

15. As per claim 11, Kambayashi et al teach a contents rental system wherein the reproducing device is authenticated by a process in which the reproducing device transmits a reproducing device public key certificate to the IC card and the IC card authenticates the reproducing device public key certificate, and wherein the IC card is authenticated by a process in which the IC card transmits an IC card public key certificate to the reproducing device and the reproducing device authenticates the IC card public key certificate (*see pps 0373*)

16. As per claim 12, Kambayashi et al teach a contents rental system wherein the reproducing device is authenticated in such a manner that the IC card encrypts a random number using a reproducing device public key and transmits the encrypted random number to the reproducing device, that the reproducing device decrypts the encrypted random number using a reproducing device secret key and transmits the decrypted random number to the IC card, and that the IC card authenticates the reproducing device using the decrypted random number (*see pps 0373*)

17. As per claim 13, Kambayashi et al teach a contents rental system wherein the IC card is authenticated in such a manner that the reproducing device encrypts a random number using an IC card public key and transmits the encrypted random number to the IC card, that the IC card decrypts the encrypted random number using an IC card secret key and transmits the decrypted random number to the reproducing device, and that the reproducing device authenticates the IC card using the decrypted random number (*see pps 0373*)

18. As per claim 14, Kambayashi et al teach a contents rental system wherein when the IC card is set to the rental business server, the rental business server authenticates the IC card in cooperation with the management center (*see fig 76, paragraphs 0004, 0014-0016, 00373, 00443)*

19. As per claim 15, Kambayashi et al teach a contents rental system wherein the IC card is authenticated by a process in which the IC card transmits an IC card public key certificate to the management center through the rental business server and the management center authenticates the IC card public key certificate (*see fig 76, paragraphs 0004, 0014-0016, 0373, 0443)*

20. As per claim 16, Kambayashi et al teach a contents rental system wherein the IC card is authenticated in such a manner that the management center encrypts a random number using an IC card public key and transmits the encrypted random number to the IC card through the rental business server, that the IC card decrypts the encrypted random number using an IC card secret key and transmits the decrypted random number to the management center through the rental

business server, and that the management center authenticates the IC card using the decrypted random number (*see fig 76, paragraphs 0004, 0014-0016, 0373, 0443)*

21. As per claim 17, Kambayashi et al teach a contents rental system wherein when the IC card is set to the rental business server, the IC card transmits a reproducing device public key certificate to the management center through the rental business server and the management center authenticates the reproducing device corresponding to the reproducing device public key certificate (*see fig 76, paragraphs 0004, 0014-0016, 0373, 0443)*

22. As per claim 18, Kambayashi et al teach a contents rental system wherein when the record medium and the IC card are set to the rental business server and the customer selects a content, the rental business server transmits contract information to the IC card, the IC card encrypts the contract information and transmits the encrypted contract information to the management center through the rental business server, after the management center decrypts the encrypted contract information and authenticates the contract information, the management center encrypts an encryption key of the content selected by the customer and transmits the encrypted content to the IC card through the rental business server, after the IC card decrypts the encrypted content encryption key and authenticates the content, the IC card transmits a normal completion message to the rental business server, and the rental business server receives the normal completion message and downloads the content to the record medium (*see fig 76, paragraphs 0004, 0014-0016, 0373, 0443)*

23. As per claim 19, Kambayashi et al teach a contents rental system wherein when the record medium and the IC card are set to the reproducing device, the reproducing device transmits a content encryption key transmission request to the IC card, the IC card receives the transmission request, encrypts a content encryption key, and transmits the encrypted content encryption key to the reproducing device, and after the reproducing device decrypts the encrypted content encryption key and authenticates the decrypted content encryption key, the reproducing device reproduces the content using the decrypted content encryption key (*see fig 76, paragraphs 0004, 0014-0016, 0373, 0443)*

Response to Arguments

24. Applicant's arguments filed October 24th, 2006 have been fully considered but they are not persuasive.

a. Applicant amend the claim and argue that and argues that the prior art taken alone or in combination fail to teach a system wherein the content storing portion interfaces with the rental business server or the reproducing device through a first data interface, and the controlling portion interfaces with the rental business server or the reproducing device through a second data interface different from the first data interface. Examiner respectfully disagrees with Applicant characterization of the prior art. Allen teaches among other thing a primary customer interface is the customer preview and order kiosks 123. These are connected to the dedicated superserver 117 to obtain customer information and order data and to allow customers to preview excerpts from movies

contained in the repertoire of the entire system. A retail outlet manufacturing controller and point of sale computer 124 is also connected to the dedicated server 117 with its associated cache. The customer can order a specific movie through the kiosk 123 and the retail computer 121 orders the manufacture of the movie and processes the transaction. The retail outlet controller 121 requests that the server 117 produce the movie on, for example, a VHS tape and the availability is checked against the local cache within server 117. If the movie is not locally available, the server 117 will request the downloading of the movie from the manufacturing controller 107.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FIRMIN BACKER whose telephone number is 571-272-6703. The examiner can normally be reached on Monday - Thursday 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FIRMIN BACKER
Primary Examiner
Art Unit 3621

November 5, 2006